

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
Jean-Luc Lesur)	Group Art Unit: 3725
Application No.: 10/524,563)	Examiner: JAMILA O. WILLIAMS
Filed: February 14, 2005)	Appeal No.: _____
For: CUSTOMISED MULTI-LAYER)	
CARD COMPRISING FRACTURE)	
INITIATION SCORES AND)	
METHOD OF PRODUCING ONE)	
SUCH CARD)	

APPEAL BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This appeal is from the decision of the Primary Examiner dated October 27, 2008 finally rejecting claims 1, 3-8, 10-12, which are reproduced as the Claims Appendix of this brief.

- ☐ A check covering the ☐ \$ 270 ☐ \$ 540 Government fee is filed herewith.
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The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.17 and 41.20 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

I. Real Party in Interest

The present application was filed in the name of Gemplus. Subsequently, Gemplus was merged into Gemalto SA. The real party of interest is Gemalto SA.

II. Related Appeals and Interferences

The Appellant, Appellant's legal representative, nor assignee, do not know of any other appeal, interferences or judicial proceedings which will affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

III. Status of Claims

The application contains Claims 1-12. Claims 2 and 9 have been canceled. Claims 1, 3-8 and 10-12 are pending and stand rejected. This appeal is directed to all pending claims.

IV. Status of Amendments

There were no amendments submitted subsequent to the October 27, 2008 Final Office Action.

V. Summary of Claimed Subject Matter

The subject matter of independent Claim 1 is directed to a personalized multilayer support 10 in the general shape of a card, such as an identification card. The support 10 includes a card body 12 which is provided on an upper face 14 with personal information 16 which is visible from the exterior of the support 10 (see Fig. 1 and page 4, lines 27-30). The support 10 also includes an at least partially transparent film 22 which is fixed to the upper face 14 of the card body 12 (see Fig. 1 and page 5, lines 1-5). Marker lines 30 and 32 comprising weld beads 30 are formed at the interface between the film 22 and the card body 12 (see Fig. 1 and page 5, lines 17-22). The weld beads 30 delimit zones of the film 22 having increased mechanical strength with respect to the film 22 being peeled off the card

body 12 (see page 5, lines 27-32). The marker lines 30 and 32 form tear scores so that the film 22 is torn at the tear scores if an attempt is made to peel off the film (see page 6, lines 24-29). The marker lines 30 and 32 depict at least one identification motif 34 and 36 which is visible from the exterior of the support 10 (see Fig. 2 and page 7, lines 3-12).

The subject matter of dependent Claim 3 is directed to a personalized multilayer support 10 wherein the marker lines 30 and 32 further comprise grooves 32 formed in at least one of the faces of the film 22 (see Fig. 1 and page 6, lines 7-12).

The subject matter of dependent Claim 4 is directed to a personalized multilayer support 10 wherein the grooves 32 pass through the entire thickness of the film. (see Fig. 1 and page 6, lines 7-12).

The subject matter of dependent Claim 5 is directed to a personalized multilayer support 10 wherein the marker lines 30 and 32 further comprise grooves 32 on at least one face of the transparent film 22 and marks and/or welds 30 at the interface between the transparent film 22 and the adjacent card body 12.

The subject matter of dependent Claim 6 is directed to a personalized multilayer support 10 wherein the upper face 24 of the transparent film 22 is covered with a transparent protective layer 28 (see Fig. 1 and page 5, lines 14-16).

The subject matter of independent Claim 7 is directed to a method of manufacturing a personalized multilayer support 10 in the general shape of a card, such as an identification card. The method includes an assembly step, during which an at least partially transparent film 22 is fixed to the upper face 14 of a card body 12 (see Fig. 3A and lines 32 of page 7 - line 13 of page 8). The method also includes a personalization step, during which personal information 16 is placed on the upper face 14 of the card body 12 so that the personal information 16 is visible from the exterior of the support 10 through the transparent film 22 (see Fig. 3B and page 8, lines 14-23). The method also includes a security step that is carried out after the assembly step, during which marker lines 30 and 32 are produced by means of a laser beam so as to form weld beads 30 at the interface between the transparent film 22 and the card body 12 (see Fig. 3C and line 24 of page 8 - line 14 of page 9). the weld beads 30 delimit zones of the film 22 having increased mechanical strength

with respect to the film 22 being peeled off the card body 12 (see page 5, lines 27-32). The marker lines 30 and 32 form tear scores with a view to causing the film 22 to be torn at the tear scores if an attempt is made to peel off the film 22 see page 6, lines 24-29).

The subject matter of dependent Claim 8 is directed to a method of manufacturing a personalized multilayer support 10 wherein marker lines 30 and 32 are produced by forming grooves 32 on at least one face of the transparent film 22 (see Fig. 3C and page 6, lines 7-12).

The subject matter of dependent Claim 10 is directed to a method of manufacturing a personalized multilayer support 10 wherein marker lines 30 and 32 are produced by forming grooves 32 on at least one face of the transparent film 22 and marks and/or welds 30 at the interface between the transparent film 22 and the adjacent card body 12, in line with the grooves 30 (see the paragraph bridging pages 10 and 11).

The subject matter of dependent Claim 11 is directed to a personalized multilayer support 10 wherein at least a portion of the marker lines 30 and 32 are of the same shape as at least a portion of the personal information 16 (see page 9, lines 7-11).

The subject matter of dependent Claim 12 is directed to a method of manufacturing a personalized multilayer support 10 wherein at least a portion of the marker lines 30 and 32 are of the same shape as at least a portion of the personal information 16 (see page 9, lines 7-11).

VI. Grounds of Rejection to be Reviewed on Appeal

The October 27, 2008 Office Action (hereinafter the "Office Action") sets forth one ground of rejection. For purposes of appeal, the Board is being asked to review the following ground of rejection:

Claims 1-3, 8 and 10-12 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,579,754 to Maurer (hereinafter "Maurer").

VII. Argument

Claims 1 and 7 are the only pending independent claims.

Appellant submits that Maurer does not anticipate the invention of independent Claim 1 or of independent Claim 7.

A. Claim 1

Claim 1 recites marker lines comprising weld beads formed at the interface between a film and a card body.

In rejecting Claim 1, the Examiner states in lines 7-9 of page 3 that "[Maurer's] material remaining between the film and body after heat is transferred to the areas of 15-17 and 29, for example, by the laser constitutes a weld bead". The Examiner's position is apparently that the portion of the film between any of the areas marked 15, 16, 17 or 29 and the card inlay 13 in Maurer constitute weld beads formed at the interface between a film and a card body.

Maurer discloses two embodiments of an identification card-- Fig. 2 and Fig. 3. Regarding the Fig. 2 embodiment, lines 3-9 of column 5 of Maurer discusses card-specific personalization data 2 that can be produced on film material 11 of the card resulting from material transformations 14-20 in the cover film material.

As discussed in lines 10-13 of column 5 of Maurer, different effects in the material 11 can be selectively obtained according to the dosage of laser energy. As discussed in lines 13-19 of column 5, one material transformation results in bubbles 15 formed in the material 11 which are decomposition products of PVC material.

As further discussed in lines 20-25 of column 5 of Maurer, increasing the laser energy supply results in an increase in bubble forming and blackening of the bubbles, resulting in a channel 16. Finally, as discussed in lines 26-32 of column 5, a further increase in the laser energy supply causes a channel 17 to break open onto the card surface.

The channel 29 of the Fig. 3 embodiment is discussed in lines 56-60 of column 5 of Maurer as being a blackened channel, and appears to be equivalent to the channel 16 or channel 17 of the Fig. 2 embodiment. The above discussion of channels 16 and 17 therefore applies equally to the channel 29.

However, none of the "areas of 15-17 and 29" of Maurer are disclosed in Maurer's specification or illustrated in Maurer's figures as being formed at the interface between the film material 11 and the card inlay 13. The Examiner apparently hypothesizes that heat would be transferred to the interface in an amount sufficient to form weld beads when the "areas of 15-17 and 29" of Maurer are formed. However, the Examiner has failed to provide any rationale or evidence that weld beads would necessarily be formed at the interface. Indeed, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

For this reason, the Examiner has erred in characterizing "the material remaining between the film and body after heat is transferred to areas of 15-17 and 29" of Maurer as inherently constituting weld beads formed at the interface between a film and a card body.

Claim 1 also recites that the weld beads delimit zones of the film having increased mechanical strength with respect to the film being peeled off the card body.

Regarding this aspect of Claim 1, the Examiner states in the Response to Arguments on page 5 of the Office Action that "the melted material remaining after the laser is applied to the card constitutes a weld bead. This additional melted material would inherently provide some degree of mechanical strength in that area". The Examiner thus hypothesizes that not only would material at the interface melt during the formation of the "areas of 15-17 and 29" of Maurer, but that such melted material would inherently increase the mechanical strength at the interface with respect to the film being peeled off the card body. However, the Examiner has again failed to provide any rationale or evidence that the mechanical strength at the

interface with respect to the film material 11 being peeled off the card inlay 13 would necessarily increase as a result of formation of the "areas of 15-17 and 29" of Maurer.

Moreover, *Merriam-Webster's Online Dictionary* defines "weld" with respect to plastics to mean "to unite (plastics) in a similar manner by heating." By contrast, the objective of Maurer in forming the "areas of 15-17 and 29" is not to unite or strengthen the interface between the film material 11 and the card inlay, but simply to make certain areas of the film material 11 visible by applying heat to the middle of the film material 11 so as to burn the film material 11. While Maurer does not discuss any of the structural effects of burning the film material 11, it would appear that, if anything, there would be a weakening of the film material 11 if it were heated to the point where bubbles or a channel were created within the film material 15.

Claim 1 also recites that the marker lines form tear scores so that the film is torn at the tear scores if an attempt is made to peel off the film.

Regarding this aspect of Claim 1, the Examiner states in lines 1-4 on page 3 of the Office Action that "marker lines (15-19, 29, 30)" form "tear scores so that the film is torn if an attempt is made to peel off the film (inherently these delimited zones would provide some degree of tearing if peeling was attempted)." The Examiner thus hypothesizes that if an attempt is made to tear off the film material 11 from the card inlay 13, the film material 11 would inherently tear at the "marker lines (15-19, 29, 30)". However, the Examiner has again failed to provide any rationale or evidence that such tearing at the "marker lines (15-19, 29, 30)" of Maurer would necessarily occur.

B. Claim 7

Claim 7 recites that marker lines are produced by means of a laser beam so as to form weld beads at the interface between a transparent film and a card body.

In rejecting Claim 7, the Examiner states in lines 15-17 of page 4 that "[Maurer's] material remaining between the film and body after heat is transferred to the areas of 15-17 and 29, for example, by the laser constitutes a weld bead". The Examiner's position is apparently that the portion of the film between any of the areas marked 15, 16, 17 or 29 and the card inlay 13 in Maurer constitute weld beads

formed at the interface between a film and a card body. However, this contention is not supportable in view of the disclosure in Maurer for the same reasons as discussed in the **Claim 1** section above. For the sake of brevity, that discussion is not repeated here.

Claim 7 also recites that weld beads delimit zones of a film having increased mechanical strength with respect to the film being peeled off a card body, and that the marker lines form tear scores with a view to causing the film to be torn at the tear scores if an attempt is made to peel off the film.

The Examiner takes the position that during the formation of the "areas of 15-17 and 29" of Maurer, the mechanical strength at the interface with respect to the film being peeled off the card body would inherently increase, and that the "marker lines (15-19, 29, 30)" of Maurer would inherently form tear scores with a view to causing the film to be torn at the tear scores if an attempt is made to peel off the film. However, these contentions are not supportable in view of the disclosure in Maurer for the same reasons as discussed in the **Claim 1** section above. For the sake of brevity, those discussions are not repeated here.

VIII. Claims Appendix

See attached Claims Appendix for a copy of the claims involved in the appeal.

IX. Evidence Appendix

(none)

X. Related Proceedings Appendix

(none)

Respectfully submitted,

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VIII. CLAIMS APPENDIX

The Appealed Claims

1. (Previously Presented) Personalized multilayer support in the general shape of a card, such as an identification card, comprising:

- a card body which is provided on an upper face with personal information which is visible from the exterior of the support,
- an at least partially transparent film which is fixed to the upper face of the card body, and
- marker lines comprising weld beads formed at the interface between the film and the card body, the weld beads delimiting zones of the film having increased mechanical strength with respect to the film being peeled off the card body, the marker lines forming tear scores so that the film is torn at the tear scores if an attempt is made to peel off the film, wherein the marker lines depict at least one identification motif which is visible from the exterior of the support.

2. (Canceled)

3. (Previously Presented) Support according to claim 1, wherein the marker lines further comprise grooves formed in at least one of the faces of the film.

4. (Previously Presented) Support according to claim 3, wherein the grooves pass through the entire thickness of the film.

5. (Previously Presented) Support according to claim 1, wherein the marker lines further comprise grooves on at least one face of the transparent film and marks and/or welds at the interface between the transparent film and the adjacent card body.

6. (Previously Presented) Support according to claim 1, wherein the upper face of the transparent film is covered with a transparent protective layer.

7. (Previously Presented) Method of manufacturing a personalized multilayer support in the general shape of a card, such as an identification card, comprising:

- an assembly step, during which an at least partially transparent film is fixed to the upper face of a card body,
- a personalization step, during which personal information is placed on the upper face of the card body so that the personal information is visible from the exterior of the support through the transparent film, and

- a security step that is carried out after the assembly step, during which marker lines are produced by means of a laser beam so as to form weld beads at the interface between the transparent film and the card body, the weld beads delimiting zones of the film having increased mechanical strength with respect to the film being peeled off the card body, the marker lines forming tear scores with a view to causing the film to be torn at the tear scores if an attempt is made to peel off the film.

8. (Previously Presented) Method according to claim 7, wherein marker lines are produced by forming grooves on at least one face of the transparent film.

9. (Canceled)

10. (Previously Presented) Method according to claim 7, wherein marker lines are produced by forming grooves on at least one face of the transparent film and marks and/or welds at the interface between the transparent film and the adjacent card body, in line with the grooves.

11. (Previously Presented) Support according to claim 1, wherein at least a portion of the marker lines are of the same shape as at least a portion of the personal information.

12. (Previously Presented) Method according to claim 7, wherein at least a portion of the marker lines are of the same shape as at least a portion of the personal information.

IX. EVIDENCE APPENDIX

None

X. RELATED PROCEEDINGS APPENDIX

None